

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

KLADDERS, Henirich, et al.

Serial No.: 10/757,047

Examiner: **DOUGLAS, Steven O.**

Filed: **January 14, 2004**

Group Art Unit: **3771**

Title: **CAPSULE FOR TAKING AN ACTIVE SUBSTANCE WHICH CAN BE
INHALED**

APPLICATION FOR PATENT TERM ADJUSTMENT

Mail Stop :Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request for reconsideration of the patent term adjustment indicated in the Notice of Allowance mailed on 1 July 2010, and is being filed as an application for patent term adjustment pursuant to 37 C.F.R. § 1.705(b). The PTO calculation was for 1227 days of PTA. As summarized below, applicants believe the correct PTA should be 1278 days. This request is being filed concurrently with the payment of the issue fee, and therefore this request is timely filed under 37 C.F.R. § 1.705(b).

Pursuant to 37 C.F.R. § 1.705(b)(1) the required fee of \$200.00 set forth in 37 C.F.R. § 1.18(e) is being paid herewith, via the USPTO's electronic filing system (by authorization to charge such fee to Applicant's Deposit Account No. 02-2955).

Pursuant to 37 C.F.R. § 1.705(b)(2)(i), below is an indication of the correct patent term adjustment and the basis or bases under § 1.702 for the adjustment:

Correct Patent Term Adjustment (PTA) = 1278 days

Bases for the above PTA

(A) 764 days under 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1);

plus

(B) 165 days under 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2);

plus

(C) 366 days under 37 C.F.R. §§ 1.702(b) and 1.703(b);

minus

(D) 17 days under 37 C.F.R. § 1.704(b).

Total PTA = (A) 764 days + (B) 165 days + (C) 366 days - (D) 17 days = 1278 days

Pursuant to 37 C.F.R. § 1.705(b)(2)(ii), below is an indication of the relevant dates specified in 37 C.F.R. § 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in 37 C.F.R. § 1.703 (f) to which the patent is entitled:

(A) 764 days under 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1)

The 764 days under 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1) is calculated based on the following dates:

(1) The day after the date that is 14 months after the date on which the application was filed under 35 U.S.C. 111(a) = 15 March 2005

(2) The date of mailing of the first action under 35 U.S.C. 132 = 17 April 2007

(3) The number of days beginning on 15 March 2005 and ending on 17 April 2007 = 764 days

(B) 165 days under 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2)

The 165 days under 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2) is calculated based on the following dates:

165 days under 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2). A reply to Office Action was filed on 21 April 2008, to which a Notice of Allowance was not mailed until 2 February 2009, which was 165 days beyond the 4-month period specified in 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2) – thus, a 165 day adjustment.

(C) 366 days under 37 C.F.R. §§ 1.702(b) and 1.703(b)

(1) The day after the date that is 3 years after the date on which the application was filed under 35 U.S.C. 111(a) = January 15, 2007

(2) The date the first Request for Continued Examination was filed under 35 U.S.C. 132(b) = January 15, 2008

(3) The number of days beginning on January 15, 2007 and ending on January 15, 2008 = 366 days

The PTA specified in 37 C.F.R. § 1.703(f) to which the patent is entitled

As specified in 37 C.F.R. § 1.703(f), the term of a patent entitled to adjustment under §§ 1.702 and 1.703 shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of § 1.703, to the extent such periods are not overlapping, less the sum of the periods calculated under § 1.704.

For the instant application the sum of the periods under paragraphs (a) through (e) of § 1.703 is 1295 days, calculated as follows:

(A) 764 days delay under 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1);

plus

(B) 165 days delay under 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2);

plus

(C) 366 days delay under 37 C.F.R. §§ 1.702(b) and 1.703(b).

For the instant application the sum of the periods calculated under 37 C.F.R. § 1.704 is 17 days, as follows:

(D) 17 days under 37 C.F.R. § 1.704(b). A Final Office Action was issued on 4 October 2007, to which a response was not filed until 15 January 2008, which was 11 days beyond the 3-month period specified in § 1.704(b) - thus, a 11 day reduction. Additionally, a Final Office Action was issued on 27 October 2009, to which a response was not filed until 2 February 2010, which was 6 days beyond the 3-month period specified in § 1.704(b) - thus, a 6 day reduction.

Therefore, the PTA specified in 37 C.F.R. § 1.703(f) to which the patent is entitled is 1278 days, calculated as follows:

1295 days (the sum of the periods under paragraphs (a) through (e) of § 1.703)
minus
17 days (the sum of the periods calculated under § 1.704)
= 1278 days

With respect to 37 C.F.R. § 1.705(b)(2)(iii), the resulting patent issued on the instant application will not be subject to any terminal disclaimers.

With respect to 37 C.F.R. § 1.705(b)(2)(iv), there were circumstances during prosecution of the instant application constituting failure to engage in reasonable efforts to conclude processing or examination of the application under 37 C.F.R. § 1.704. These circumstances are as outlined above under (D) resulting in the following PTA reduction: 17 days under 37 C.F.R. § 1.704(b) [for responses filed 15 January 2008 and 2 February 2010], for a total of PTA reduction of 17 days.

Accordingly, Applicants respectfully request that the PTA specified in the notice of allowance (stated therein to be 1227 days) be corrected to 1278 days for the reasons as outlined above.

The Commissioner is hereby authorized to charge any additional fees associated with this response or credit any overpayment to Deposit Account No. 02-2955.

Respectfully submitted,

/Wendy Petka/

Wendy A. Petka, Reg. No. 53,459

Attorney for Applicants

Patent Department
Boehringer Ingelheim Corp.
900 Ridgebury Road
P.O. Box 368
Ridgefield, CT. 06877
Tel.: (203) 791-6614
Fax: (203) 798-4408

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